

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Koningstein	Art Unit : 3622
Patent No. : 7,930,206	Examiner : William A. Brandenburg
Issue Date : April 19, 2011	Conf. No. : 1968
Serial No. : 10/748,681	
Filed : December 31, 2003	
Title : SYSTEM AND METHOD FOR ENABLING AN ADVERTISEMENT TO FOLLOW THE USER TO ADDITIONAL WEB PAGES	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT

In a Decision on Request for Reconsideration of Patent Term Adjustment (“Decision”) dated June 21, 2011, the United States Patent and Trademark Office (“Office”) denied Patentee’s Application For Patent Term Adjustment (PTA) Under 37 C.F.R. § 1.705(d) filed June 17, 2011, for the above patent. The Office did not agree that “B Delay” should not be reduced by 113 days for the period under which the application was not under continued examination.

The USPTO Incorrectly Excluded from B Delay a Period that Does Not Correspond to Time Consumed by Continued Examination

The Decision stated that the patent is entitled to 1,355 days of PTA. Patentee maintains that the patent is entitled to 1,468 days of PTA, for the reasons provided below.

“A Delays” are defined as delays by the USPTO under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt USPTO response. It is Patentee’s understanding that there is no dispute that there was one period of A Delay (March 1, 2005, to April 16, 2008) for a total of 1,143 days.

“B Delays” are defined as delays by the USPTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentee submits that B Delay accumulated for a total of 1,570 days, beginning on January 1, 2007 (the day after the date that is three years after the date on which the application was filed), and ending April 19, 2011 (the date the patent was issued). The Office has excluded from B Delay the number of days corresponding to the period beginning on January 26, 2009 (the date on which a Request for

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: September 21, 2011.

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Continued Examination was first filed) and ending on April 19, 2011 (the date the patent was issued). However, this entire period should not be excluded from B Delay because it does not correspond exactly to continued examination. The Examiner's mailing of a Notice of Allowance Action on December 28, 2010, closed examination of the application on that date. Section 154(b)(1)(B)(i) of Title 35 excludes from B Delay "time consumed by continued examination of the application." The statute does not provide for exclusion from B Delay of time from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur).

The legal issue presented in the preceding paragraph is currently the subject of a civil action against the USPTO in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). The plaintiff in Abbott Biotherapeutics Corp. v. Kappos has argued that the USPTO improperly calculated the length of the statutory delay period defined by 35 USC 154(b)(1)(B) by subtracting from the delay period the number of days from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). In the event that the USPTO is unwilling to increase PTA for the present patent in the manner requested herein, Patentee requests that a final decision on this petition be held in abeyance pending the final resolution of the litigation in Abbott Biotherapeutics Corp. v. Kappos. A decision in Abbott Biotherapeutics Corp. v. Kappos will likely settle the legal issue that is central to the present petition.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 16113-0639001.

Respectfully submitted,

Date: September 21, 2011

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